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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,465	04/13/2000	Robert F. Bencini	15916-261	7431
7590 02/13/2006 Henricks Slavin & Holmes LLP 840 Apollo Street Suite 200 El Segundo, CA 90245			EXAMINER SIRMONS, KEVIN C	
			ART UNIT 3767	PAPER NUMBER

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/548,465

Applicant(s)

BENCINI ET AL.

Examiner

Kevin C. Sirmons

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 24-26, 43-48, 50-54 and 64-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20, 21, 24, 43-48, 50-54, 65 and 66 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 11, 17-19, 23, 26, 64 and 67 is/are rejected.
- 7) ☒ Claim(s) 68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Specification (2<sup>nd</sup> time)***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Anti-tear means.

The disclosure is objected to because of the following informalities: It is the Examiner's position that Applicant has evoked sixth paragraph, means-plus-function language to define Applicant's invention. Therefore the Examiner requires the Applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, **what structure**, materials, and acts **perform the function recited in the claim element**. Please note that the MPEP clearly states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to the means-(or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, **the PTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o)...**". (Also see MPEP 2181 (Rev. 1, Feb.2000)) See Anti-tear means

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 5, 11, 17-19, 23, 26, 64 and 67 are rejected under 35

U.S.C. 102(b) as being anticipated by Webster, Jr. U.S. Pat. No. 5,431,168.

Webster discloses an elongate body (10), the distal portion of the elongate body defining a proximal end and being more flexible than the proximal portion (col. 3); a steering wire (36); a stiffening member, entirely located inward of the outer surface of the elongate body, and defining a proximal end that is substantially adjacent to the proximal end of the elongated body distal portion (38); a handle (fig. 8 and see handle throughout specification); as to claim 2, (stiffening member lumen (22) and stiffening member (62); as to claim 4, (38 and/or 48); as to claim 5, (38 and/or 48); as to claim 11, (38 and/or 48)); as to claim 17, (fig. 1); as to claim 18, (see above rejections); as to claim 19, (fig. 1); as to claim 22, (figs. 1 and 4); as to claim 23, (fig. 4 and (51)); as to claim 64, an elongate body (10); a stiffening member (48); anti-tear means (49) and steering wire (36); as to claim 67, (49); as to claim 25, elongate body (10); steering wire (36); anchoring member (19); anti-tear device (glue 49 on the proximal end of 48); stiffening member (48/51).

### ***Response to Arguments***

Applicant's arguments filed 5/26/05 have been fully considered but they are not persuasive.

With respect to claim 1, clearly the sleeve (38) correspond to the claimed "stiffening member" since applicant has provided little **structure** to define "stiffening

member.” As to the stiffening member (38), the claim only requires the stiffening member (38/48) to be secured to the elongated member. Webster clearly discloses this fact (col. 4, lines 36-49). Therefore, it is the examiner position that the stiffening member at the very least is attached to the elongated body (col. 4, lines 46-49).

As to claim 2, the stiffening member has very little structure. Therefore, substantially anything within the Webster patent could be regarded as a stiffening member. Secondly, the stiffening members (62) have some amount of stiffness. It may not have the same amount of stiffness as applicant stiffening member, but it still has some amount of stiffness nonetheless. Additionally, applicant has not indicated in the claims or the specification, how much stiffness the stiffening members are required to have.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specification, which describes a plethora of exemplary stiffening member. [See, e.g. Figure 6-10b and page 12, line 16 to page 16, line 18]]) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Simply, **the burden** is on applicant to include structure within the claim to define the stiffening member over the prior art of record. The examiner and anyone of ordinary skill in the art can plainly see that there is structure disclosed in the specifications and drawings that applicant can be placed in

the claim in order to overcome the prior art of record. Therefore, applicant has failed to overcome the prior art of record with regard to claim 2.

As to claim 64, the examiner has taken the position that, Webster coil 48 corresponds to the stiffening member” and that the glue 49 corresponds to the “anti-tear means.” There is a variety of absolute support in Webster associated with this interpretation of the claims. For example, the specification in reference to figs. 1 and 2 clearly indicates that the anti-tear means (49) is used to secure the coil spring (48) and performs the function recited in the claimed means-plus-function element. Additionally, applicant argues that “there is nothing in the Webster patent which even indicates that the glue 49 is adhered to, or otherwise interacts with, the sleeve 38”. Unfortunately, figs. 1 and 4 clearly disclose and describes interaction between the anti-tear means (49) and the stiffening member (48). It is the examiner’s position that based on the evidence provided, the anti-tear means (49) of Webster is fully capable of performing the function as set forth in the claim. Therefore, the rejection is maintained.

#### ***Allowable Subject Matter***

Claims 20, 21, 24, 43-48, 50-52, 53, 54, 65 and 66 are allowable over the prior art of record.

Claim 68 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

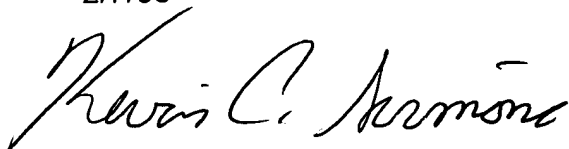
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Sirmons whose telephone number is 571-272-4965. The examiner can normally be reached on Monday-Friday 6:30-4:00 ALT FRI.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Sirmons  
Primary Examiner  
Art Unit 3767  
2/7/06

A handwritten signature in black ink, reading "Kevin C. Sirmons". The signature is written in a cursive style with a large, sweeping initial "K".